

Application No.: 09/575,410
Amendment

R E M A R K S

Reconsideration of the application in view of the above amendments and following remarks is respectfully requested. In the above amendment claims 1 and 14 have been amended and no claims have been canceled or added. Therefore, claims 1-24 are pending in the application.

Claim Rejections under 35 U.S.C. § 103

The Examiner rejected claims 1-24 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,270,011 to Gottfried ("Gottfried") in view of U.S. Patent No. 6,393,139 to Lin et al. ("Lin et al."), and further in view of U.S. Patent No. 5,815,252 to Price-Francis ("Price-Francis"). Applicant respectfully traverses these rejections.

In his last amendment (filed March 3, 2004) Applicant overcame the rejection of claim 1 by amending that claim to recite randomly selecting which fingerprints will be requested "by using a fingerprint numbering scheme designated by a user". The Examiner now asserts that the newly cited reference to Lin et al. discloses this limitation. Applicant respectfully disagrees with this assertion.

Applicant has further amended independent claim 1 in order to help clarify the distinctions between that claim and the Lin et al. reference. Specifically, the claim has been amended to recite that the fingerprint numbering scheme is designated by a user "whose fingerprints will be requested". This amendment is supported by Applicant's specification at, for example, page 3, lines 28-30, and page 7, lines 13-22, as well as original claims 8 and 21. Applicant has amended independent claim 14 in a similar manner as claim 1.

Applicant's amendment to claims 1 and 14 clarify that the user whose fingerprints will be requested is the person who

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designates the labels (e.g., F₁, F₂, F₃, etc.) for his or her fingerprints. In other words, the user whose fingerprints will be requested is the person who designates any fingerprints he or she chooses as fingerprints F₁, F₂, F₃, etc. In this way the user designates the fingerprint numbering scheme and the user does not use a pre-determined fingerprint numbering scheme.

Applicant submits that Gottfried in view Lin et al., and further in view of Price-Francis does not establish a *prima facie* case of obviousness of Applicant's amended independent claims 1 and 14. Specifically, the Examiner states that "Lin et al. discloses a fingerprint scheme designated by the user (see col. 3, lines 33-36, col. 4, lines 27-30)." (Final Office Action mailed 05/20/2004, page 2, last two lines). Applicant notes that the Examiner states "fingerprint scheme" and not "fingerprint numbering scheme" as is recited in Applicant's claim 1. The portions of Lin et al. cited by the Examiner refer to the user being able to program a fingerprint entering sequence, but the cited portions of Lin et al. do not disclose that the user can designate a fingerprint numbering scheme. In fact, FIG. 1 of Lin et al. makes it clear that the fingers are already designated by the numbers L1, L2, L3, etc. and that the user uses these predetermined designations in programming the fingerprint entering sequence. Therefore, Lin et al. do not disclose that the user can designate a fingerprint numbering scheme as is recited in Applicant's claims.

Furthermore, Applicant has found nothing in Lin et al. that would suggest that the user whose fingerprints will be requested is the person who designated the fingerprint labels shown in Lin et al.'s FIG. 1. Again, Applicant's claims 1 and 14 have been amended to recite that the fingerprint numbering

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scheme is designated by a user "whose fingerprints will be requested".

Therefore, the Examiner has not established a *prima facie* case of obviousness of Applicant's amended independent claims 1 and 14 and the rejections must be withdrawn.

Applicant submits that the rejection of Applicant's original, unamended independent claim 8 should also be withdrawn for reasons similar to as discussed above. Specifically, claim 8 recites "assigning a number to each entered fingerprint that is consistent with a number intended by a user who entered the fingerprints" and "storing the received fingerprint data and assigned numbers in a database". In this way, a user can designate the numbering scheme for the fingerprints as described above. Furthermore, the numbers are consistent with a number intended by a user "who entered the fingerprints." Again, Lin et al. do not disclose that the user who entered the fingerprints can designate a fingerprint numbering scheme. Instead, Lin et al. relies on the predetermined fingerprint designations shown in FIG. 1. Therefore, Applicant submits that a *prima facie* case of obviousness of Applicant's independent claim 8 has not been established and that the rejection should be withdrawn.

The rejections of claims 2-7, 9-13 and 15-24 should also be withdrawn for at least the above reasons due to their dependence on their respective independent claims.

In addition, with respect to dependent claims 22-24, the Examiner has taken Official Notice that it is well-known in the art to store more than ten fingerprints. Namely, because the Examiner has not cited a specific reference that actually teaches storing more than ten fingerprints, the Examiner has based the rejection on Official Notice in order to fill the gaps not taught by the cited references. Applicant hereby

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traverses this reliance on Official Notice.

Specifically, the Manual of Patenting Examining Procedure (MPEP) states that the use of official notice without documentary evidence "should be rare", that assertions of technical facts in the areas of specific knowledge of the prior art "must always be supported by citation to some reference work recognized as standard in the pertinent art", and that it is never appropriate to rely solely on common knowledge in the art "without evidentiary support in the record" as the principal evidence upon which a rejection is based. MPEP § 2144.03(A).

Moreover, recent Federal Circuit case law has called into question the legitimacy of the use of common knowledge to supply missing knowledge or prior art to reach an obviousness judgment. For example, in Al-Site Corp. v. VSI Int'l. Inc., 174 F.3d 1308, 1324 (Fed. Cir. 1999), the court stated "[r]arely, however, will the skill in the art component operate to supply missing knowledge or prior art to reach an obviousness judgment. . . . Skill in the art does not act as a bridge over gaps in substantive presentation of an obviousness case . . .". And in In re Lee, 277 F.3d 1338, 1344 (Fed. Cir. 2002), the Court stated that the Board of Patent Appeals and Interferences' conclusion that they could find obviousness without "any hint or suggestion in a particular reference" was an "[o]mission of a relevant factor . . . [and as a result] . . . both legal error and an arbitrary agency action". These cases illustrate that the reliance on "common knowledge" or "well-known" prior art to supply missing knowledge in a rejection is fraught with problems from a legal point of view. Thus, Applicant submits that the Examiner must provide support for such official notice through documentary evidence.

Applicant submits that the concept of storing more than

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ten fingerprints that the Examiner has officially noticed is not considered to be common knowledge or well-known in the art. This is because people only have ten fingers and so one would think that the upper limit to the number of fingerprints that may be scanned is a total of only ten fingerprints, as in the Price-Francis reference. Furthermore, the use of skill in the art to supply missing components of Applicant's claims is discouraged by the controlling authority because this approach utilizes improper hindsight.

Having traversed the Examiner's assertion of Official Notice, the MPEP mandates that "the Examiner must provide documentary evidence in the next office action if the rejection is to be maintained." MPEP § 2144.03(C). Accordingly, the Examiner has not established a proper *prima facie* case of obviousness of Applicant's claims 22-24 and the rejections must be withdrawn.

Fees Believed to be Due

No extra claims fees are believed to be due.

A Fee Transmittal is included herewith to cover the fee for the RCE.

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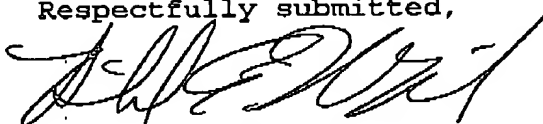
C O N C L U S I O N

In view of the above, Applicant submits that the pending claims are in condition for allowance. Should there remain any outstanding issues that require adverse action, it is respectfully requested that the Examiner telephone Richard E. Wawrzyniak at (858)552-1311 so that such issues may be resolved as expeditiously as possible.

Respectfully submitted,

Dated

7/29/04



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